

REMARKS

This is a full and timely response to the outstanding final Office Action mailed April 17, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does at least lacks a suggestion or motivation to combine and modify the references in the manner suggested in the Office Action.

A. Rejection of claims 1-5, 7-18, and 20-21

Claims 1-5, 7-18, and 20-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shachar* (U.S. Pat. No. 5,923,736) and *Hillson et al.* (“Hillson,” U.S. Pat. No. 6,148,346). Applicant respectfully traverses this rejection.

In the Office Action, it is acknowledged that Shachar does not teach the use of markup language documents on a printing device that define menu pages presented on the printing device. In view of that fact, the Office Action identifies the Hillson reference, which, it is argued, teaches a “touch sensitive menu screen to present menu pages having selectable menu items, similar to the apparatus of Shachar.” *Office Action*, page 2. In addition, the Office Action argues that “Hillson teaches a dedicated printing device (at col. 6, lines 50-55), and selectable menu items relating to printing with a dedicated printing device (at col. 16, lines 31-41).” *Office Action*, page 2. In view of those arguments, the Office Action concludes:

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Shachar and Hillson before him at the time the invention was made to modify the purpose device of Shachar to include the dedicated printing device of Hillson. One would have been motivated to make such a combination for the advantage of providing more complete services to a user, such that the user may print out messages and copies of selected data.

Office Action, page 3.

As a first matter, Applicant notes that, contrary to that alleged in the Office Action, Hillson does *not* teach a “touch sensitive menu screen to present menu pages”. In fact, Hillson is silent to both “touch” screens or touch “sensitive” screens, as a simple word search of the Hillson reference reveals. Therefore, a basic presumption upon which the rejection is based is false, calling into

question the propriety of the rejection. Hillson does not discuss an interface of the printing device, and instead is only concerned with user interfaces that are presented to the user *on a host computer*. See, e.g., *Hillson*, column 4, lines 36-57.

Turning the “motivation” for the combination and modification presented in the Office Action, there is absolutely no suggestion or motivation provided *by the prior art* for the proffered combination or modification. Specifically, Shachar is concerned with *telephones*, and Hillson is concerned with *printers*. There is no reason why a person having ordinary skill in the art to transform Shachar’s simple telephone into a printer in view of Shachar’s or Hillson’s disclosures. To do so would turn an inexpensive, small calling device into an expensive, large piece of office equipment. Obviously, converting Shachar’s telephone into a printer changes the fundamental nature of the telephone, and neither Shachar nor Hillson identifies any reason why anyone would want to make that type of transformation.

Given the obvious lack of a suggestion or motivation contained *in the prior art* for the proposed combination and modification, it is clear that the only suggestion or motivation comes from Applicant’s own disclosure and the desire to manufacture a reason to reject Applicant’s claims. As is well established in the law, such hindsight to the Applicant’s own disclosure is *per se* improper. See *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention). In particular, the rejection reflects a clear attempt to cull disparate components from the prior art and combine them, without any legitimate basis for doing so, in hindsight to Applicant’s disclosure for the purpose of rejecting Applicant’s claims. For at least that reason, the rejections are improper and should be withdrawn as to each of Applicant’s claims.

With specific regard to dependent claims 7 and 8, Applicant notes that neither Shachar nor Hillson teaches or suggests a “local server module” of a printing device that is configured to serve markup language documents to the printing device screen *and* to a remote computer. Applicant notes that column 13, lines 42-54, which was identified in the Office Action, describes Shachar’s telephone/terminal as *receiving content from* a remote computer (i.e., “server”), *not serving content to* a remote computer.

B. Rejection of Claim 6

Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shachar* and *Hillson* in view of *Yan et al.* (“Yan,” U.S. Pat. No. 6,003,065). Applicant respectfully traverses this rejection.

As is identified above, Shachar and Hillson do not teach aspects of Applicant’s claims. In that Yan does not remedy the deficiencies of the Shachar and Hillson references, Applicant respectfully submits that claim 6, which depends from claim 1, is allowable over the Shachar/Hillson/Yan combination for at least the same reasons that claim 1 is allowable over Shachar/Hillson.

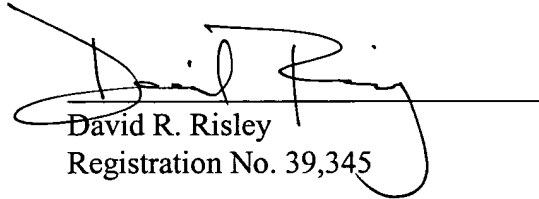
II. Canceled Claims

Claims 18-35 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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5-23-06
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Signature